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To: Board of Appeals; Attn: Craig
Feinberg

From: Elliot Goldberg

Fax: 703-308-6199

Date: October 31, 2002

Phone:

Pages: (including cover sheet)

Your Ref.: 06/900,360 Batch E-2

Our Ref.: 2569-0103P

Re:

CC:

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

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Comments: **As per our telephone interview today, enclosed is a copy of a Letter we submitted on October 17, 2002. Also enclosed is the stamped copy of the postcard receipt. We submitted three copies of this Letter as indicated on the postcard. Thank you for your attention to this matter.**

Box AF
PATENT
2569-0103P

RECEIVED

IN THE U.S. PATENT AND TRADEMARK OFFICE

OCT 31 2002

Applicant: Wells OBRECHT

Conf.: 8032

Appl. No.: 08/900,360

Group: 3623

BOARD OF PATENT APPEALS
AND INTERFERENCES

Filed: July 25, 1997

Examiner: S. MEINECKE DIAZ

For: METHOD AND APPARATUS FOR PROCURING
GOODS IN AN AUTOMATED MANNER

COMMENTS DIRECTED TO DELAYED OFFICE ACTION DATED AUGUST 23, 2002

B x AF
Assistant Commissioner for Patents
Washington, DC 20231

October 17, 2002

Sir:

FACTS

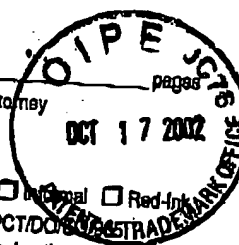
(1) In an order from the Board of Appeals mailed August 7, 2002, the Application was remanded to the Examiner for a second time.

(2) The purpose of the last remand was for an appropriate consideration of the Declaration filed July 3, 2001 which was never commented on, by the Examiner.

(3) This letter is only directed to the comments in an Office Action of August 23, 2002 made by the Examiner regarding the Declaration filed July 3, 2001.

Papers Filed herewith on: 10-17-02
DOCKET NO.: 2509-1039 ATTY.: TCB REAG
APPLICANT(S): UBRECHT
APPLN. NO: 08/900,360 FILED: 7-25-97
PAT NO.: _____

- ☐ New Application with Transmittal Letter
☐ Utility ☐ Design ☐ CIP ☐ PCT ☐ Provisional
☐ Filing Under 37 CFR 1.53(b) ☐ CONT ☐ DIV
☐ Filing Under 37 CFR 1.53(d) (CPA)
☐ Filing Under 37 CFR 1.114(RCE)
☐ Specification Consisting of: _____ pages
☐ Combined Declaration & Power of Attorney
☐ Assignment / Cover Letter
☐ Letter to Official Draftsman
☐ Drawings _____ Sheets ☐ Formal ☐ Informal ☐ Red-Ink
☐ Completion of Filing Requirements, PCT/DOCS or Formalities Letter and Executed Declaration
☐ Priority Document(s) / Cover Letter, No. Doc. _____
☐ Amendment: _____
☐ Transmittal Ltr ☐ Large Entity ☐ Small Entity
☐ Response
☐ Information Disc Stmt. PTO-1449(s) _____ ref(s)
☐ Notice of Appeal ☐ Appeal Brief
☐ Issue Fee Transmittal
☐ FEES:
☒ Letter: Comments on OA dated 8-23-02
☐ Other: Bioprocess



DOCKET NO. 2509-1039

Receipt is hereby acknowledged of the papers filed as indicated in connection with the above identified case.
COMMISSIONER OF PATENTS AND TRADEMARKS
Due Date: _____
Handcarry: _____

Application No.: 08/900,360

Comments

In the Office Action dated August 23, 2002 there were statements regarding the Declaration filed on July 3, 2001. As this is the first opportunity the Appellant has had in responding to the Examiner's comments this letter is considered timely and should be entered and considered by the Board of Appeals.

Initially, the Examiner quotes the MPEP 715.07, apparently asserting that there is no explanation of the facts in the Declaration.

The Examiner also states, "Appellant has presented no specific evidence to support conception and due diligence regarding the development of the claimed invention." Apparently the Examiner is directing attention to the Declaration filed on July 3, 2001, but the statement of the Examiner is true speculation and no reasons have been identified why the evidence presented was deficient. For example, in section 6, on page 2 of the Declaration, specific facts were given which clearly related to diligence. A more detailed explanation of this Declaration is not considered necessary as it is of record.

Also, the Examiner stated that the "Appellant has quoted the Examiner out of context," the quotation in the paragraph bridging pages 2 and 3 of the comments is correct. However, the inventor was relying on the statement that was positively included in the Examiner's answer which is as follows, "however, the inventor only need swear back to at least December 14, 1995 to overcome the disclosure of the internet embodiment of source interactive software." (emphasis added)

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Also the Examiner now makes a statement as follows:

Even if Appellant were to provide evidence to this effect, Appellant must still swear beyond the non-internet version of source interactive back as far as August 22, 1995 (as disclosed in reference "U, Interactive Buyer Net Poland Interactive Software Inc. acquired new software introduced")

The above statement is actually a new reason advanced by the Examiner. This was never part of an explanation of the rejection. A new requirement by the Examiner, is improper and goes beyond the remand order.

Certainly if the Examiner considers that the rejection should have been further clarified the application should have been reopened to give the opportunity for the Appellant to respond to this. By just putting this comment, which in fact is a new requirement in the letter of August 23, 2002, denies the appellant due process.

Also even a cursory review of the "U" document does not indicate what facts are present in this document to reject the claims.

Conclusion

If the Examiner has any questions concerning this application, the Examiner is requested to contact Elliot Goldberg, Reg. No. 33347, at the telephone number of (703) 205-8000.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By  #33347
Terrell C. Birch, #19,382

TCB/EAG/kdb
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